Exhibit 5

[redacted]

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Paper 13
Entered: December 12, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

IPR2023-00847
Patent 10,268,608 B2

Before JON M. JURGOVAN, SHEILA F. McSHANE, and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Samsung Electronics Co., Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 1–12 of U.S. Patent No. 10,268,608 B2 (Ex. 1001, "the '608 patent"), along with the Declaration of Dr. Robert Wedig. Paper 1 ("Pet."); Ex. 1003. Netlist, Inc. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). In the Preliminary Response, Patent Owner indicates that it filed a statutory disclaimer disclaiming claims 6–12 of the '608 patent. Prelim. Resp. 2–3 (citing Ex. 2001). With authorization, Petitioner filed a Reply (Paper 9, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 10, "PO Sur-reply").

Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a) (2018). Upon consideration of the Petition, the Preliminary Response, Petitioner's Reply, and Patent Owner's Sur-reply, along with the evidence of record, we determine that Petitioner has established a reasonable likelihood of prevailing with respect to the unpatentability of at least one claim of the '608 patent. Accordingly, for the reasons that follow, we institute an *inter partes* review of claims 1–5 of the '608 patent.

A. Related Matters

The parties indicate this Petition is related to the following district court litigations:

Netlist, Inc. v. Micron Technology, Inc., No. 1:22-cv-00136 (W.D. Tex.);

Netlist, Inc. v. Samsung Electronics Co., Ltd., No. 2:22-cv-00293 (E.D. Tex.);

obvious over Hiraishi, Butt, and Ellsberry with or without Tokuhiro. Pet. 72–109. At this stage, we find that Petitioner's showing as to obviousness under the first ground is sufficient for institution, and the other grounds will be addressed at trial.

IV. CONCLUSION

For the foregoing reasons, we determine that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing at least one of claims 1–5 of the '608 patent is unpatentable under 35 U.S.C. § 103.

V. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–5 of the '608 patent on the grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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Patent 10,268,608 B2

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